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Re:	In re Application of: Eric Bornstein		
	Serial No.: 10/649,910		
	Filing Date: August 26, 2003		
	Title: Near Infrared Microbial Elimination Laser System		
	Art Unit: 3735		
	Docket No.: 72287-019		

Message:

Please enter the attached Petition From Requirement For Restriction Under 37 C.F.R. §1.144.

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PAGE 1/5 * RCVD AT 7/16/2007 2:12:04 PM [Eastern Daylight Time] * SVR:USPTO-EFAX-2/22 * DNIS:2738300 * CSID:1 617 535 3800 * DURATION (mm-ss):01:46

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

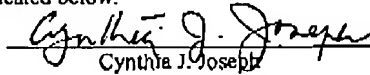
In re Application of: Eric Bornstein
Application Serial No.: 10/649,910
Filing Date: 26 August 2003
Title: NEAR INFRARED MICROBIAL ELIMINATION LASER
SYSTEM
Examiner: Shay, David M.
Art Unit: 3735
Atty. Docket No.: 072287-0019
Confirmation No.: 5770

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Cynthia J. Joseph

Mail Stop Petition
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PETITION FROM REQUIREMENT FOR RESTRICTION
UNDER 37 C.F.R. § 1.144

Applicant hereby petitions the Director to review the Examiner's requirement for restriction among the claims (1-22) for the above-identified application.

In the Office Action mailed 29 December 2007, the Examiner issued a restriction requirement under 35 U.S.C. § 121 among the claims of the subject application (the Examiner had issued a previous restriction requirement but removed it after traverse by the Applicant). For the restriction requirement, the Examiner divided the claims into two groups:

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- I. Claims 1-20, drawn to a laser system, classified in class 606, subclass 13; and
- II. Claims 21-22, drawn to a method of destroying bacteria, classified in class 422, subclass, 22.

In concluding that restriction between the identified groups was proper, the Examiner stated "[i]n this case the apparatus could be used to illuminate tissue to determine the degree of oxygen saturation of the blood therein."

In the Amendment filed 28 March 2007, Applicant traversed the Examiner's restriction requirement and respectfully requested reconsideration in accordance with 37 CFR § 1.111, while at the same time electing the claims of Group II, i.e., claims 21-22.

Applicant's argument against the restriction requirement included that the rationale for the requirement was erroneous, and therefore that restriction requirement was improper. More specifically, the Applicant stated that in supplying the rationale for the restriction requirement, the Examiner failed to consider all of the limitations present in the pending claims. Applicants further alleged that, as explained below, the Examiner either ignored the plain text of the claims at issue, or introduced *sua sponte* extraneous limitations to the claims. By doing so, the Examiner failed to comply with the requirements of MPEP § 806.01, which requires that "In passing upon matters of double patenting and restriction, it is the claimed subject matter that is considered." Also, in doing so, the Examiner failed to comply with MPEP § 806.05(e), which states that between claims directed to a process and apparatus for its practice, restriction is appropriate if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. As one skilled in the art would appreciate, the near infrared laser(s) of Applicant's claimed systems are not used for illumination purposes, in contrast with the Examiner's proposed alternative use.

Claims 1-20 of the subject application are directed to near infrared laser systems used for the destruction of bacteria in a bacterial locale. For example, claim 11, representative of the system claims of the subject application, recites the following:

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11. A laser system for destroying bacteria in a bacterial locale, said system comprising:
- (a) a housing and a control;
 - (b) a laser oscillator sub-system within said housing for causing the selective emission under said control of first radiation narrowly at a first wavelength range of 870nm and the selective emission under said control of second radiation at a second wavelength range of 930nm; and
 - (c) a head for delivering said first radiation and said second radiation from said laser oscillator sub-system to the site of said bacterial locale;
 - (d) said first radiation and said second radiation being adapted to generate a chromophore from said bacterial locale and being adapted to cooperate with said chromophore to destroy bacteria in said bacterial locale.

Applicant submitted (and maintain) that one skilled in the art, when reading claims 1-20 in light of the specification, would understand that these claims are directed to use of near infrared lasers producing infrared energy in two specific near infrared (NIR) wavelength ranges, invisible to the naked eye, to destroy bacteria at a bacterial locale (e.g., infected tissue) or mitigate deleterious effects produced by such bacteria. The Applicant argued further that, when considering the limitations of claims 1-20 as required by MPEP § 806.01 and MPEP § 806.05(e), the recited laser systems do not include any detectors to detect any absorption of the near infrared energy in tissue irradiated by such radiation. Therefore, the Examiner's supplied rationale for the restriction requirement, i.e., that "the apparatus could be used to illuminate tissue to determine the degree of oxygen saturation of the blood therein," was based on elements not actually recited in the claims at issue.

Thus, when supplying the rationale for claim restriction, the Examiner either ignored the plain text of the claims at issue, or introduced *sua sponte* extraneous limitations not actually present in the claims. In either event, by doing so, the Examiner failed to comply with the requirements of MPEP § 806.01 and MPEP § 806.05(e), which are directed to the claimed subject matter.

In the Office Action mailed 29 June 2007, the Examiner maintained the restriction

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requirement, making the requirement final. In responding to Applicant's traverse submitted by way of the Amendment of 28 March 2007, the Examiner argued that:

Applicant argues that the examiner's basis for restriction is erroneous as it based on "elements not recited in the claims". The examiner respectfully notes that the instant claims are comprising-type claims, and thus encompass combinations of elements including all other elements in combination with those claimed. As such, these claims would also encompass any device with various detectors, including, for example, those devices used to determine oxygen saturation. Thus, applicant's arguments are not convincing.

[Emphasis added]

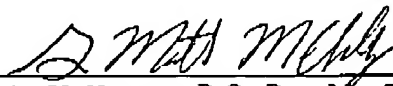
Applicant respectfully takes issue with the Examiner's noted conclusion that the presence of "comprising" as the linking term of a claim necessarily means that any limitations can be read into the claim for the purposes of restriction analysis. Applicant's attorneys are not aware of any controlling authority that would support the Examiner's contention, and further believe that such an interpretation would actually render MPEP § 806.01 and MPEP § 806.05(e) essentially meaningless.

For the reasons stated above, the Applicant respectfully submits that the restriction requirement issued by the Examiner is improper. Accordingly, the Director is requested to review the restriction requirement and direct that it be removed, so that system claims 1-20 can again be considered for the prosecution of the subject application. Authorization is hereby given to charge any fees that may be due, or credit any overpayment, to Deposit Account Number 50-1133.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

Date: 16 July 2007


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